

T.D. INFORMAL MEMO: DO NOT MAIL THIS MEMO TO APPLICANT

DATE: 26-Jun-03

APPL. S.N.: 09/440,529

TO: EXAMINER Tremblay, Mark

ART UNIT: 2827

FROM: Preston, Renee

**PARALEGAL SPECIALIST**

RETURN THIS MEMO TO: CP4-6D34

SUBJECT: Decision on Terminal Disclaimer (T.D.) filed: 24-Mar-03

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next Office action to notify applicant of the T.D. If you disagree or have any questions, please see me or the Special Program Examiner. THIS IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE (1) MAILED TO APPLICANT OR (2) PLACED OF RECORD IN THE APPLICATION FILE. When your action is complete, please initial, date and return this memo to me. THANK YOU.

- ☒ The T.D. is PROPER and has been recorded (see ¶ 14.23).
- ☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below (see ¶ 14.24):
- ☐ The TD fee of  has not been submitted nor is there any authorization in the application file for the use of a deposit account (see ¶ 14.26.07).
- ☐ The T.D. does not satisfy Rule 321 in that the person who has signed the T.D. has not stated the extent of his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent (see ¶¶ 14.26 & 14.26.01).
- ☐ The T.D. lacks the enforceable only during common ownership clause - needed to overcome a non-statutory double patenting rejection, Rule 321(b) (see ¶ 14.27.01).
- ☐ The T.D. is directed to a particular claim(s), which is not acceptable since "the disclaimer must be for a terminal portion of the term of the entire patent to be granted" (MPEP 1490) (see ¶¶ 14.26 & 14.26.02).
- ☐ The person who signed the T.D.:
- ☐ is not an attorney "of record" (see ¶¶ 14.29 and 14.29.01).
- ☐ has failed to state his/her capacity to sign for the business entity (see ¶ 14.28).
- ☐ is not recognized as an officer of the assignee (see ¶¶ 14.29 & possible 14.29.02).
- ☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame number specified as to where such evidence is recorded in the Office (see 37 CFR 3.73(b) and 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame number may be found in the T.D. or in a separate paper of record in the application (see ¶ 14.30).
- ☐ The T.D. is not signed (see ¶¶ 14.26 & 14.26.03).
- ☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting rejection is missing or incorrect (see ¶ 14.32).
- ☐ The serial number of this application (or the number of the patent in reexam or reissue cases being disclaimed is missing or incorrect (see ¶¶ 14.26, 14.27.02 or 14.26.05).
- ☐ The period disclaimed is incorrect or not specified (see ¶¶ 14.26, 14.27.02 or 14.26.03).
- ☐ Other:
- ☐ Suggestion to request refund (see ¶ 14.36). NOTE: If already authorized, credit refund to deposit account and do not check this item.

I have appropriately notified applicant(s) of the status of the Terminal Disclaimer filed in this case.

Ex. Initials: \_\_\_\_\_ Date: \_\_\_\_\_


Log Date:

Special Program Database, Version 2.1

(Rev. 5/98)

Routing Slip Printed On:

Thursday, June 26, 2003 9:54:32 AM

<b>Application Number</b> 	<b>Application No.</b> 09/440,529	<b>Applicant(s)</b> PITRODA ET AL.	

<b>TERMINAL DISCLAIMER</b>	<input type="checkbox"/> <b>APPROVED</b>	<input type="checkbox"/> <b>DISAPPROVED</b>
Document Code - DISQ	This patent is subject to a Terminal Disclaimer	
<b>INTERNAL DOCUMENT – DO NOT MAIL</b>		

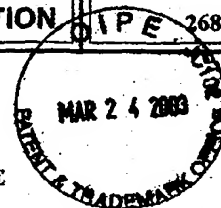
U.S. Patent and Trademark Office

**TERMINAL DISCLAIMER TO OBVIATE A PROVISIONAL DOUBLE  
PATENTING REJECTION OVER A PENDING SECOND APPLICATION**

Docket No.

2683/76979

In re Application of: **Pitroda, et al.**  
Application No. **09/440,529**  
Filed: **November 15, 1999**  
For: **POINT OF SALE ADAPTER FOR ELECTRONIC TRANSACTION DEVICE**



TERMINAL DISCLAIMER  
APPROVE:

JUN 26 2003

TECHNOLOGY CENTER  
SPECIAL PROGRAM CENTER

The owner, **Satyan G. Pitroda and Merul Patel** of **100** percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173 as shortened by any terminal disclaimer filed prior to the grant of any patent granted on pending second Application Number **09/587,998**, filed on **June 6, 2000**. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the second application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of any patent granted on the second application, as shortened by any terminal disclaimer filed prior to the patent grant, in the event that any such granted patent: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims cancelled by a reexamination certificate, is reissued, or in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

Check either box 1 or 2, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney of record.

3. Owner/applicant is ☒ Small entity ☐ Large entity

The terminal disclaimer fee under 37 CFR 1.20(d) is **\$55.00** and is to be paid as follows:

- ☒ A check in the amount of the fee is enclosed.

- ☐ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number **23-0920**. A duplicate copy of this sheet is enclosed.

PTO suggested wording for terminal disclaimer was

- ☒ unchanged. ☐ changed (if changed, an explanation should be supplied.)

*Walter J. Kawula, Jr.*  
Signature

Dated: **3/17/2003**

Name and Address of Person Signing

**Walter J. Kawula, Jr., Esq.**  
**WELSH & KATZ, LTD.**  
**120 S. Riverside Plaza, 22nd Floor**  
**Chicago, Illinois 60606**  
**(312) 655-1500**


**RENEE PRESTON**  
**PARALEGAL SPECIALIST**  
**TECHNOLOGY CENTER**

I certify that this document and fee is being deposited on **03/17/03** with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

*Walter J. Kawula, Jr.*  
Signature of Person Mailing Correspondence

**Walter J. Kawula, Jr.**

Typed or Printed Name of Person Mailing Correspondence

<b>Serial Number</b> 	Application No.	Applicant(s)	
	09/440,529	PITRODA et al.	

<b>TERMINAL DISCLAIMER</b>		<input checked="" type="checkbox"/> <b>APPROVED</b>		<input type="checkbox"/> <b>DISAPPROVED</b>	
The term of this patent shall not extend beyond the expiration date of U.S. Patent No:					
The term of this patent subsequent to the adjacent date has been disclaimed.					
<b>INTERNAL DOCUMENT – DO NOT MAIL</b>				<b>Document Code - DISQ</b>	

U.S. Patent and Trademark Office

----- TERMINAL DISCLAIMER -----

APPLICATION: 09/440,529

RE: TERMINAL DISCLAIMER:

RELATED APPLICATION(S) 09/587,998,  
\_\_\_\_\_, HAS

(HAVE) NOT ISSUED AS OF 6-26-2003.

**DO NOT REMOVE NOTE UNTIL 09/587,998 HAS BEEN ISSUED A PATENT NUMBER  
AND DOCUMENTED ON FACE OF FILE 09/440,529.**